

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 19- 27 and 31 have been amended. Claims 1 – 31 are currently pending.

Judicially Created Double Patenting Rejection

Claims 1, 4, 7 – 17 and 19 – 31 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1 – 6, 8, 9, 13, 15, 16, 20, 25, 27 and 30 – 34 of Application No. 10/691,887 (hereinafter the “’887 Application”). After the mailing of the most recent Office Action, the ‘887 Application issued as U.S. Patent No. 7,159,188 (hereinafter the “’188 Patent”) on January 2, 2007. As such, the allegedly conflicting claims have now been patented.

In order to avoid further expense and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejection in compliance with 37 C.F.R. §1.321 (b) and (c). Applicants’ filing of the terminal disclaimer should not be construed as acquiescence of the Office Action’s obviousness-type double patenting rejection. Attached is the terminal disclaimer and accompanying fee (37 C.F.R. § 1.20(d)).

Rejections based on 35 U.S.C. §112

Claims 20 – 26 recite the limitation “computer-implemented method” in line 1. The Office Action states there is insufficient antecedent basis for this limitation in the claims. Applicants have amended claims 20 – 26 in light of this rejection and respectfully request withdrawal of any rejections under 35 U.S.C. 112.

Rejections based on 35 U.S.C. § 102

Claims 1 – 4 and 7 – 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by Amro, *et al.*, U.S. Patent No. 5,680,561 (hereinafter “Amro”). Applicants have amended independent claims 1, 19, 27 and 31 in response to this rejection. Claims 1, 19, 27 and 31 now require a “preview display [that] includes actual content from said displayed item which would be displayed in response to a user input representing a selection to view the set of data associated with the displayed item.” Amended independent claims 1, 19, 27 and 31 also now require that the claimed actual content be “selected by utilization of a content selection algorithm that determines which content from said displayed item will be useful to a user in making one or more navigational choices.” Applicants respectfully submit that Amro does not teach these aspects of amended independent claims 1, 19, 27 and 31.

At the outset, in the interest of efficiency and expedience Applicants refer the Examiner’s attention to the prosecution of the ‘887 Application. As noted by the Office Action with respect to the double patenting rejection, the instant application and the ‘887 Application are directed to at least some similar subject matter.

During prosecution of the ‘887 Application, similar claim amendments were made that overcome prior art rejections over the Amro reference and that allowed the application to issue. As in the present case, each independent claim of the ‘887 Application was subject to rejections under 35 U.S.C. § 102 as being unpatentable over Amro. In response to these rejections, Applicants made claim amendments that distinguished their claims from Amro, and the ‘188 Patent issued shortly thereafter. The amendments made during prosecution of the ‘887 Application are commensurate in scope with and substantially similar to the claim amendments

now made in this Response. As was the case during the prosecution of the '887 Application, Amro does not teach a preview that includes “actual content from said displayed item which would be displayed in response to a user input representing a selection to view the set of data associated with the displayed item.”

Amro discloses a graphical user interface (GUI) for allowing a user to locate specific pages within a compound document. When in “the search mode,” the GUI displays a “mini window,” which presents an outline “of the compound document’s page corresponding to the position of elevator 310 within scroll bar 320.” Amro, col. 3, ll. 25 – 28. Using the outlines presented in the mini window, a user may locate a desired page of the compound document.

Amro generates an outline for each document page and stores these outlines in a database. In response to a user opening a document, the GUI loads every document page into RAM memory and scans the pages for layout information (i.e., the types of content on a page and its layout). Amro, col. 3, ll. 60 – 65. Using this layout information, the GUI creates an outline for each page and stores these outlines in a database table. Amro, col. 4, ll. 6 – 8.

It is important to note that the outlines of Amro do not include actual content from the compound document. Rather, the outlines indicate the layout and types of content on a page - an outline “includes boxes having various symbols therein to indicate the portion of the corresponding page having text, a picture object, spreadsheet object, and so on.” Amro, col. 3, ll. 29 – 32. As an example, “if the top 30% of a page contains text, then the top 30% of the mini window will contain a box having lines therein.” Amro, col. 3, ll. 34 – 36. Figure 5 provides an exemplary outline for a page. The box 510 is a symbol indicating that text is present within that portion of the corresponding page, while the empty space within the box 520 indicates that a picture object is present within that portion of the corresponding page. Amro, col. 3, ll. 43 – 48.

As demonstrated by Figure 5, the outline includes only symbols, not the actual content of the compound document.

Because the outlines taught by Amro do not include actual content from the item, Amro does not teach a preview that includes “actual content from said displayed item which would be displayed in response to a user input representing a selection to view the set of data associated with the displayed item, wherein said actual content is selected by utilization of a content selection algorithm,” as required by amended independent claims 1, 19, 27 and 31. Accordingly, Applicants respectfully submit that independent claims 1, 19, 27 and 31 are in condition for allowance.

Applicants also submit that dependent claims 2 - 18, which depend from claim 1, are in condition for allowance for at least the same reasons discussed above with respect to claim 1. Further, Applicants submit that dependent claims 20 - 26, which depend from claim 19, are in condition for allowance for at least the same reasons discussed above with respect to claim 19. Applicants also submit that dependent claims 28 - 30, which depend from claim 27, are in condition for allowance for at least the same reasons discussed above with respect to claim 27.

Rejections based on 35 U.S.C. § 103

Dependent Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Amro. Claims 5 and 6 depend from independent claim 1. As discussed above, claim 1 is patentable over Amro. Claims 5 and 6 include all of the limitations of claim 1 and are also patentable over Amro for at least the reasons stated above.

Conclusion

For the reasons stated above, claims 1 – 31 are now in condition for allowance. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

/rhr/ Robert H. Reckers

Robert H. Reckers
Reg. No. 54,633

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, Missouri 64108-2613
Phone: 816/474-6550
Fax: 816-421-5547